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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,429	05/22/2002	Horst Trombach	02576	2373
987	7590	03/04/2005	EXAMINER	
SALTER & MICHAELSON THE HERITAGE BUILDING 321 SOUTH MAIN STREET PROVIDENCE, RI 029037128			ELOSHWAY, NIKI MARINA	
			ART UNIT	PAPER NUMBER
			3727	

DATE MAILED: 03/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/009,429

Applicant(s)

TROMBACH ET AL.

Examiner

Niki M. Eloshway

Art Unit

3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-33 is/are pending in the application.
- 4a) Of the above claim(s) 28-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on January 21, 2005 has been entered.

Election/Restrictions

2. Newly submitted claims 28-33 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 28-33 are drawn to a method of making a tab and claims 1-27 are drawn to a film composite. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process which includes coating the upper surface of the lower layers instead of the entire lower surface of the upper layer.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 28-33 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-13, and 15-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Han et al. (U.S. 4,934,544) in view of McCarthy (U.S. 5,0074,111). Han et al. discloses the claimed invention except for the fold being in the uppermost layer only. McCarthy teaches that it is known to provide a grasping tab and fold from the uppermost layer alone (see element 24). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the composite film of Han et al. with the fold and grasping tab being formed by the uppermost layer alone, in order to reduce the amount of material used by providing a single layer in the folded tab.

Han et al. teach a film composite, shown in figures 1-3, having an adhesive layer 34, 38, a sealing layer 32, a facing layer 40 and a fold at 24. See figures 8 and 9 for claims 9 and 10.

Regarding claims 4 and 21, the modified film of Han et al. discloses the claimed invention except for the specific percentages of the two areas on either side of the fold. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the modified film composite of Han et al. with the smaller area on one side of the fold comprising between 40 and 50 percent of the surface, since a change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955), and since it has been held that "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Art Unit: 3727

Regarding 7, 8, 18 and 19, the modified film of Han et al. discloses the claimed invention except for the specific length of the fold. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the modified film composite of Han et al. with the fold extending roughly 1.0 to 1.5 cm from the fold bottom to the fold tip, since a change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955), and since it has been held that "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

5. Claims 1-8, 11-13, 16-21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCarthy (U.S. 5,0074,111) in view of Han et al. (U.S. 4,934,544). McCarthy discloses the claimed invention except for the fold being a double fold. Han et al. teaches that it is known to provide a grasping tab with a double fold. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the composite film of McCarthy with the fold being a double fold, as taught by Han et al., in order to increase the strength of the tab.

McCarthy teaches a film composite 20 having a plurality of layers 24/40, 36 and 26. The uppermost layer is comprised of elements 24 and 40. The layer beneath the uppermost layer is element 36 and adhesive 38 is therebetween. The upwardly projecting fold is shown in fig. 1.

Regarding claims 4 and 21, the modified film of McCarthy discloses the claimed invention except for the specific percentages of the two areas on either side of the fold. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the modified film composite of McCarthy with the smaller area on one side of the fold comprising between 40 and 50 percent of the surface, since a change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Art Unit: 3727

Regarding 7, 8, 18 and 19, the modified film of McCarthy discloses the claimed invention except for the specific length of the fold. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the modified film composite of McCarthy with the fold extending roughly 1.0 to 1.5 cm from the fold bottom to the fold tip, since a change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955), and since it has been held that "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Response to Arguments

6. Applicant's arguments filed January 21, 2005 have been fully considered but they are not persuasive. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). When Han et al. is used as the primary reference, the secondary reference of McCarthy is used only for the teaching of the upper layer forming the graspable tab. The graspable tab of Han et al. is modified by McCarthy so that it is formed by the upper layer. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

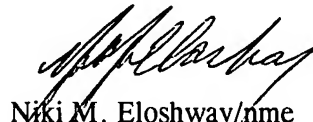
Art Unit: 3727

Conclusion

7. THIS ACTION IS NON-FINAL.

8. In order to reduce pendency and avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly to (703)872-9306. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a USPTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX will be promptly forwarded to the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Niki M. Eloshway whose telephone number is (571) 272-4538. The examiner is in the office on Thursdays and Fridays. Any inquiry of a general nature or relating to the status of this application should be directed to the 3700 Receptionist at (703) 308-1148.


Niki M. Eloshway/nme
Patent Examiner
February 25, 2005